

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/783,867	Applicant(s) HARVEY ET AL.	
	Examiner Nathan M. Nutter	Art Unit 1796	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 28 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

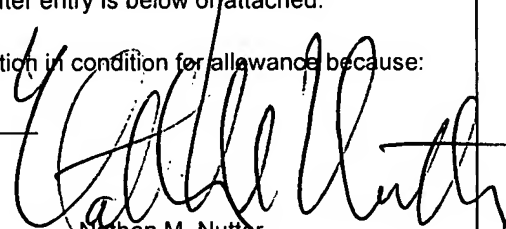
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: NONE.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 45-61.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.



Nathan M. Nutter  
Primary Examiner  
Art Unit: 1796

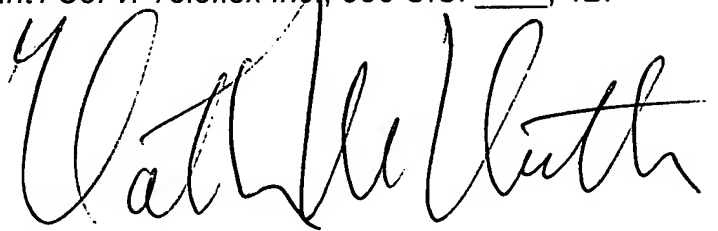
The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Note the section titled "Response to Arguments" beginning at page 6 of the Final Rejection mailed 28 September 2007. It is pointed out to applicants that the claims are drawn to combinations of elements known in the art and used for their known utilities.

The combination of the teachings of the references renders the claim obvious primarily because such a combination of known elements is considered to yield predictable results insofar as the combined elements operate wholly in the expected and customary manner as previously recognized by those skilled in the art. See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_, 127 S. Ct. 1727, 1739 (2007) (explaining that the "combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results"). Here, the Specification and/or Applicant's remarks provide no apparent evidence or reasoning supporting the conclusion that the claimed combination of known elements "work[s] together in an unexpected and fruitful manner" or "create[s] some new synergy," thereby rebutting the above contention that the claimed combination enacts little more than "the predictable use of prior art elements according to their established functions." *Id. at 1740.*

Applicant's assertion that the previous rejection under 35 U.S.C. § 103(a) is invalid because the Examiner has engaged in impermissible hindsight reconstruction is unpersuasive. The employment of hindsight analysis is necessary for the examination of the claims, however, it is not permissible for the Examiner to rely on or become biased by *ex post* factors that came to be known only after the effective date of the

present application. See, e.g., *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_, 127 S. Ct. 1727, 1742 (2007). Nonetheless, the examination should not be confined by "[r]igid preventative rules that deny factfinders recourse to common sense," *Id.*, and an analysis under § 103 "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ" *Id.* at 1741. Here, the previously cited rationale for combining the teachings of the references cited was based wholly on inferences and conclusions drawn from the prior art existing at the time of the invention and did not rely on information or teachings that were unknown to those skilled in the art prior to Applicant's effective date. Accordingly, the analysis is not considered to suffer from hindsight bias.

"When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_, 127 S. Ct. 1727, 1742 (2007).



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